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**THIS DISPOSITION IS
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OF THE TTAB**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: September 12, 2005

Cancellation No. 92043533

Jacques M. Dulin, Esq. and
Innovation Law Group, Ltd.

v.

Charles E. Gotlieb, Esq.

Before Hairston, Holtzman, and Walsh, Administrative
Trademark Judges.

By the Board:

On June 21, 2000, respondent, Charles E. Gotlieb, filed an application for registration of the mark INNOVATION LAW GROUP on the basis of his bona fide intent to use the mark in commerce.¹ Following the submission of a statement of use on March 12, 2004, wherein first use in commerce as of March 9, 2004 was asserted, the registration issued.

Petitioners, Jacques M. Dulin and Innovation Law Group, Ltd., filed a petition to cancel the registration, claiming prior use of the identical mark for legal services and a likelihood of confusion between the parties' marks. The petition also alleges that respondent "does not and did not,

¹ Reg. No. 2854860 for the mark INNOVATION LAW GROUP for "legal services relating to intellectual property law and strategy," registered June 15, 2004.

at any of the five times he filed for requests for extensions to file a Statement of Use, have a bona fide intention to use the INNOVATION LAW GROUP mark," that respondent "has engaged in fraud in Defendant's executed declarations," and that "such fraud constitutes fraud on the United States Patent [and] Trademark Office for which he should be sanctioned." Respondent filed an answer denying the salient allegations in the complaint.

This case now comes up on petitioners' motion for summary judgment on the pleaded ground of likelihood of confusion. Respondent filed a response to the motion, and a cross-motion for summary judgment on likelihood of confusion and on petitioners' pleaded claim of fraud. Petitioners responded to respondent's cross-motion and also cross-moved for summary judgment in petitioners' favor on the fraud claim. Each of these motions has been fully briefed.²

Summary judgment is appropriate where the movant has established that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). If the movant meets its initial burden, the burden then shifts to the non-moving party to present sufficient evidence to show an evidentiary conflict as to one or more material facts in issue. See

² We have considered the parties' reply briefs as they clarify the issues before us. See Trademark Rule 2.127(a).

Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). In considering whether to grant or deny a motion for summary judgment, the Board may not resolve issues of material fact, but can only ascertain whether genuine disputes exist regarding such issues. The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

THE PARTIES' CROSS-MOTIONS ON FRAUD

We first address the parties' cross-motions for summary judgment on the issue of fraud. Petitioners indicate that they have fully briefed the cross-motions on the assumption that the Board could treat the petition to cancel as having stated a fraud claim. Petitioners contend, however, that they have not pleaded such claim, noting: "As to the fraud issue, Petitioners have not brought a fraud claim in their Petition to Cancel... ." *Petitioners' Response To Defendant's Cross Motion For Summary Judgment, and Petitioners' Cross Motion For Summary Judgment For Fraud*, p. 2.

In light of petitioners' above statement, to the extent that the petition to cancel may be construed as having pleaded fraud as a ground for cancellation, we consider it withdrawn.

Accordingly, both respondent's motion and petitioners' cross-motion for summary judgment on the fraud claim are denied as moot.

THE PARTIES' CROSS-MOTIONS ON LIKELIHOOD OF CONFUSION

Turning to the parties' cross-motions for summary judgment on the issue of priority and likelihood of confusion, we first note that there is no genuine issue of material fact that a likelihood of confusion exists. There is no dispute that the marks of the parties are identical and are used in association with the same services. The issue before us on the cross-motions for summary judgment is which party has priority of use of the mark.

Petitioners' Supporting Evidence

Petitioners' motion for summary judgment is supported by the declarations and accompanying exhibits of petitioner Jacques M. Dulin; Diane van Os and Robert F. Dennis, former employees of Innovation Law Group, Ltd.; Kathleen Dal Bon, a patent attorney colleague of Mr. Dulin; and Virginia P. Shogren, an associate attorney of Innovation Law Group, Ltd.

In his declaration, Mr. Dulin contends that he first used the mark INNOVATION LAW GROUP in 1997; that on March 30, 2000, he licensed use of his mark to a partnership named Innovation Law Group LLP; that his partner resigned in mid-May 2000; that he then established Innovation Law Group, Ltd. as the corporate successor to the partnership, and that

the corporation now uses his mark under license. His declaration is accompanied by evidence of use of the mark from 1997 to 2000, including business cards distributed at an out-of-state meeting on May 3, 2000, and PowerPoint presentation slides used by Mr. Dulin during a presentation on May 23, 2000 in Finland.

In her declaration, Ms. van Os states that in her capacity as an employee of Innovation Law Group, Ltd. (a position she held from May 1, 2000 to July 14, 2000), she prepared various correspondence on Innovation Law Group, Ltd.'s letterhead and sent these to clients. She also sent letters to Mr. Dulin's former law firm regarding the transfer of client files from the firm to "Innovation Law Group" and filed a "Continued Prosecution Application Request Under 37 C.F.R. § 1.53(d)" with the USPTO, which lists Mr. Dulin at "Innovation Law Group" as the correspondence addressee. Each of these bears dates between May 1, 2000 and June 21, 2000.

Mr. Dennis describes Mr. Dulin's use of the mark in 1997; Ms. Dal Bon states her awareness of Mr. Dulin's use of the mark in 1997 and in May, 2000; and Ms. Shogren attests to activities that took place in 2004.

Based on the evidence provided, petitioners have shown use of the mark in commerce from at least as early as May 1, 2000.

Respondent's Supporting Evidence

Respondent submits the declaration of Charles E. Gotlieb and accompanying exhibits to show that respondent's first use of the mark predates June 21, 2000,³ and that petitioner Dulin abandoned his mark in 1998 and did not begin using it again until after June 21, 2000.

Respondent attempts to show that while Mr. Dulin may have used the mark in 1997, he abandoned it in 1998 when he went to work for a private law firm. Accompanying respondent's declaration is evidence showing that from 1997 to 1999, Mr. Dulin filed patent applications and other correspondence with the USPTO as an employee of the private law firm and without any reference to "Innovation Law Group." Mr. Gotlieb also shows that Mr. Dulin was listed in the Martindale Hubbell guide for attorneys in 1993, 1994, 1996-2000 and 2002, but that the listings make no reference to "Innovation Law Group."

Whether this evidence shows that Mr. Dulin abandoned his mark in 1998 is an issue that we need not reach. Significantly, none of the evidence presented raises a genuine issue of material fact as to petitioners' use of the

³ Respondent may rely upon June 21, 2000, the filing date of the registration, as his date of first use of the mark in commerce. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c); see generally McCarthy, J. Thomas, 2 *McCarthy on Trademarks and Unfair Competition*, § 26:17 (4th ed.).

mark at least as early as May 1, 2000, which date is earlier than any date on which respondent is entitled to rely.

The earliest date of use on which respondent is entitled to rely, absent other evidence, is the June 21, 2000 filing date of the underlying application. Respondent has not submitted persuasive evidence that he used the mark before June 21, 2000. Respondent is also entitled to prove a date of use earlier than June 30, 2000, the first use date stated in the statement of use that he filed in the underlying application, but that proof must be clear and convincing evidence that is not "characterized by contradictions, inconsistencies and indefiniteness." *Elder Manufacturing Co. v. International Shoe Co.*, 194 F.2d 114, 118, 92 USPQ 330, 332 (CCPA 1952).

The statements in respondent's declaration are characterized by inconsistency. In his declaration, Mr. Gotlieb first states that he has been using the mark "in connection with legal services relating to intellectual property law and strategy at least since March 9, 2004." *Declaration of Charles E. Gotlieb*, para. 1, p. 1. Respondent next alleges use of the mark "in connection with my legal services as a patent attorney with the Martindale Hubbell guide for attorneys in the year 2000, and it has appeared in the print version of the guide each year from 2001-2004." *Declaration of Charles E. Gotlieb*, para. 3, p. 2.

Moreover, the Martindale Hubbell listings are not themselves clear and convincing evidence of respondent's use of the mark predating May 1, 2000. Copies of four pages from the print version of the guide are attached to respondent's declaration. Each page contains a single line-item listing for "Charles E. Gotlieb," certain biographical data, and the words "The Innovation Law Group." In the upper right-hand corner of each page is a year date; the earliest date listed appears to be either "2000" or "2001." There is no month or day provided, so that even if the date is 2000, it could well be subsequent to May 1, 2000. In short, the listings do not conclusively establish a date prior to May 1, 2000.

In view thereof, respondent has not shown as a matter of law that he is entitled to rely on a first use date before June 21, 2000, or that genuine issues of material fact exist as to whether petitioners are entitled to rely on May 1, 2000 as the date of their first use of the mark in commerce.

CONCLUSION

Based on the evidence presented, we find as a matter of law that petitioners have established priority of use of the mark INNOVATION LAW GROUP and a likelihood of confusion with respondent's use of the identical mark for similar services. Petitioners have demonstrated use of the mark since at least

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as early as May 1, 2000. The earliest date of use that respondent can rely upon is his constructive use date of June 21, 2000.

Accordingly, petitioners' motion for summary judgment on the issue of priority and likelihood of confusion is hereby granted; respondent's cross-motion for summary judgment on priority and likelihood of confusion is hereby denied. The petition to cancel is hereby granted and the registration will be cancelled in due course.

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